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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/199,566	11/25/1998	HIROYUKI SAITO	981391	3839
38834	7590	07/14/2005	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			ROSEN, NICHOLAS D	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/199,566

Applicant(s)

SAITO ET AL.

Examiner

Nicholas D. Rosen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 41-63 have been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 41-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not adequately describe a control unit configured to receive data related to an official certificate from a public institution, wherein the financial institution, the public institution, and the passport are different institutions.

Claims 51-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not adequately describe receiving data related to an official certificate from a public institution, wherein the financial institution, the public institution, and the passport are different institutions.

Claims 54-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not adequately describe a public institution; and a passport transaction apparatus including a control unit configured to receive data related to an official certificate from a public institution, wherein the financial institution, the public institution, and the passport are different institutions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 41-50

Claims 41-44 and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776) in view of "Polaroid Demonstrates Digital ID System with Electronic Portrait and Signature Storage for Drivers Licenses, Security Passes" (hereinafter "Polaroid"), and official notice. As per claim 41, Watanabe discloses an identification card transaction apparatus, comprising: a data input unit configured to receive from the applicant input data including at least one of personal information of the applicant, a code number of the card, and a handwritten signature of the applicant (column 2, lines 40-53; column 12, lines 21-40; column 15, lines 21-40); and an image input unit configured to take a photograph of the applicant, and to input an image of the applicant (column 14, line 12, through column 15, line 31); a control unit configured to transmit information to a remote site, transmitting personal information received or input and data related to the official certificate (Figure 10A; column 12, lines 31-33); an identification document issuing unit configured to prepare and output an ID using the photograph taken by the image input unit when issuance is allowed (Figure 7, column 6, line 39, through column 10, line 62); and a cash processing unit configured to receive and provide cash from and to the applicant when the fee is paid by cash (column 5, lines 49-55). Watanabe does not expressly disclose that the control unit is configured to transmit the image input by the image input unit to the remote site via a network, but "Polaroid" teaches transfer of data, including portraits, between many issuing stations and a central data base (whole article; see especially paragraphs

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beginning "The system then prints" and "Portraits, signature, and alphanumeric data"), making such configuration of a control unit obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention, for the stated advantage of making the portrait/image and other data readily available for instant verification, updating, or reissue.

Watanabe does not disclose that the issuing unit includes in the identification document a handwritten signature input by the data input unit, but "Polaroid" teaches identification cards with signatures (two paragraphs beginning from "At the touch of a button"). Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to include a signature, and consequently have a data input unit configured to receive signatures, for the obvious advantage of aiding in identifying persons, and making it more difficult to gain unauthorized access, make fraudulent purchases, etc., with a forged signature.

Watanabe does not disclose a card processing unit configured to receive a card for an applicant's account at a financial institution, and to read data on the card; the control unit configured to transmit the code number of the card and data read by the card processing unit via a network to the financial institution, and to receive information of the applicant from the financial institution when the financial institution identifies the applicant based on the code number and the data transmitted, and then to communicate with the financial institution to process a payment based on the data read by the card processing unit and the code number, when a fee for the identification document application is to be paid with the card; but official notice is taken that this is

what is done routinely when a customer pays for a good by scanning his credit card or other card (e.g., bank debit card) in a merchant's scanner, and the card number and other information is transmitted to the card issuer or other financial institution to arrange for payment. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply this to paying a fee for a passport or other identification document application in particular, for the obvious advantage of enabling the ID document applicant to pay the fee conveniently.

Watanabe does not quite expressly disclose receiving data related to an official certificate of the applicant from a public institution distinct from the passport center (or, in his case, license center), although his disclosure of using information from a certificate of residence may qualify (column 13, lines 31-45). However, official notice is taken that it is well known to receive data related to an official certificate of an applicant from a public institution distinct from the center granting a desired certificate, e.g., using a driver's license to help establish one's identity when applying for a passport, or vice versa, or using a birth certificate for such a purpose. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to receive data related to an official certificate of the applicant from a public institution distinct from the passport center, for the obvious advantage of helping to establish the document applicant's identity.

Watanabe does not expressly disclose that his invention is for passports, but does teach that it relates to a certification card with a certification photo, such as a

driver's license or a personal identification card (column 1, lines 7-9), and passports are personal identification documents which generally contain certification photos. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to apply Watanabe's methods to producing passports.

As per claim 42, the remote site in Watanabe is a host computer for a license center (Figure 2; column 4, lines 27-35).

As per claim 43, Watanabe does not disclose that the identification document transaction apparatus is connected to the financial institution and the public institution via the passport (or driver's license) center, but does disclose that the apparatus is connected to a host computer (Figure 2; column 4, lines 27-35). Official notice is taken that it is well known to connect to external institutions through a host computer. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention for the passport apparatus is connected to the financial institution and the public institution via the passport center, for the obvious advantages of enabling the passport center to monitor and verify external communications, and maintain data security by passing communications through a firewall.

As per claim 44, Watanabe discloses a processing unit configured to receive an issued license and read contents of the issued license (column 12, lines 21-40), and discloses receiving and inputting corrected contents as the personal information when

the contents read are required to be corrected (column 12, line 41, through column 13, line 57; Figure 10A).

As per claim 47, Watanabe does not disclose that the document transaction apparatus further comprises a voice input/output unit configured to output a voice guidance to the applicant, but does disclose accepting input by voice (column 13, line 64, through column 14, line 5); and official notice is taken that it is well known to use voice input/output units to provide guidance by voice. (An example with which millions of people must be familiar, often to their frustration, is the kind of voicemail system in which voice messages are outputted to the caller and voice input is taken from the caller.) Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to have the apparatus further comprise such a voice input/output unit, configured as recited, for the obvious advantages of conveniently providing instructions to people who may be imperfectly literate, providing instructions by voice to save people the trouble of attempting to read instructions while at the same time entering data, and saving the expense of a display screen as opposed to a microphone, and for the stated advantage of communicating with an applicant without requiring him to take his eyes off an eye test machine.

As per claim 48, Watanabe does not disclose that the data input unit is a touch panel display, but official notice is taken that touch panel displays are well known. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention for the data input unit to

comprise a touch panel display, for the obvious advantage of conveniently responding to a user's entries, and displaying appropriate instructions.

As per claim 49, Watanabe discloses the card processing unit reading personal information of an applicant directly from a recording medium (column 12, lines 21-40).

As per claim 50, Watanabe discloses that the recording medium is an IC card (column 12, lines 21-40).

Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, "Polaroid," and official notice as applied to claim 41 above, and further in view of Sukegawa et al. (U.S. Patent 5,235,165). As per claim 45, Watanabe does not expressly disclose a receipt issuing unit configured to issue a receipt on which authentication data for identifying the applicant when the applicant returns to the transaction apparatus on a later day to receive a passport is printed, but Sukegawa teaches apparatus configured to issue a receipt (column 9, lines 7-15). Watanabe discloses registering data at the center with personal information of the applicant (column 12, lines 31-60). Watanabe does not disclose that the issuing unit is configured to issue the identification document to the applicant based on authentication data input by the applicant via the data input unit on a later day and the authentication registered at the passport center, but official notice is taken that it is well known to provide goods and services based on authentication of a customer. Hence, it would have been obvious to one of ordinary skill in the art of identification document preparation at the time of applicant's invention to have the apparatus configured to issue a receipt on which is printed authentication data for authenticating the applicant, and to issue the

identification document to the applicant based on authentication data input by the applicant via the data input unit on a later day and the authentication registered at the passport center, for the obvious advantage of easing issuance, when, for a variety of reasons, a passport could not be issued at once. (Reasons might include lack of stock of passport blanks, the need to verify certain information, or summon human beings to make sensitive decisions, etc. For that matter, the present examiner has several times in his life applied for and obtained passports, and, if his recollection serves, passports were not issued until some days after he had gone to the Post Office, paid the requisite fees, submitted photographs, etc.)

As per claim 46, Watanabe discloses issuing the identification document based on the stored image of the applicant and an image of the applicant who comes to the transaction center (column 14, lines 12-40; column 15, lines 32-43).

Claims 51-53

Claims 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776), "Polaroid," and official notice. Claims 51 and 52 are closely parallel to claims 41 and 42, respectively, and rejected on the same grounds.

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, "Polaroid," and official notice as applied to claim 51 above, and further in view of Sukegawa et al. (U.S. Patent 5,235,165). Claim 53 recites nothing substantially different from the limitations of claims 45 and 46, and is therefore rejected on the same grounds set forth for those claims.

Claims 54-63

Claims 54, 55, 56, 57, 60, 61, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Patent 5,717,776), "Polaroid," and official notice. Claims 54, 55, 56, 57, 60, 61, 62, and 63 are closely parallel to claims 41, 42, 43, 44, 47, 48, 49, and 50, respectively, and rejected on the same grounds.

Claims 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe, "Polaroid," and official notice as applied to claim 54 above, and further in view of Sukegawa et al. (U.S. Patent 5,235,165). Claims 58 and 59 are closely parallel to claims 45 and 46, respectively, and rejected on the same grounds.

Response to Arguments

Applicant's arguments filed April 28, 2005, have been fully considered but they are not persuasive. Applicant's arguments are also to some extent mooted by Applicant's canceling of previous claims, and submission of new claims which do not recite quite the same limitations as those addresses in the arguments.

However, much that is already of record in the case can be reiterated. Examiner has made new rejections of the new claims, but believes that there is motivation for all of the combinations made, either in the art relied upon or in the knowledge generally available to one of ordinary skill in the art. Regarding official notice, Examiner observes that his takings of official notice in rejecting the present claims do not involve technical facts in areas of esoteric technology, but largely relate to his own experience in applying for a driver's license and passport, and to common practice in paying for purchases with

a credit card, a matter in which Examiner, like millions of other people, also has personal experience.

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chapman (U.S. Patent 6,902,108) discloses a method and apparatus for providing identification.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, but **this will be changed** to 571-273-8300 as of July 15, 2005. Non-official/draft communications can be faxed to the examiner at 571-273-6762. Note that official amendments, arguments, and other responses should be faxed, if they are sent by fax, only to the official fax number for the organization.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen

NICHOLAS D. ROSEN
PRIMARY EXAMINER

July 9, 2005